In re application of:

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Serial No.:   09/471,696

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For: METHOD AND SYSTEM FOR AUCTIONING
A PRODUCT ON A COMPUTER NETWORK

Attorney Docket No.:   1649 (USW 0546 PUS)

Group Art Unit: 3627

Examiner: J. KRAMER

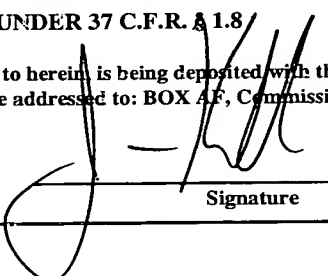## APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Box AF
Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

This is a brief in support of an appeal from the final rejection of claims 1-9, 11-19, and 21-23 in the final Office Action mailed on September 24, 2002.

I. Real Party In Interest

The real party in interest is Qwest Communications International Inc., a corporation organized and existing under the laws of the State of Delaware, and having a place of business at Denver, Colorado. US West, Inc. merged with Qwest Communications International Inc. The original assignment to US West, Inc. was recorded on December 23, 1999, at reel 010481 and frame 0299.

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II. Related Appeals and Interferences

There are no other appeals or interferences known to the Applicant, the Applicant's legal representative, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-9, 11-19, and 21-23 are pending in this application (reproduced for reference in the attached Appendix) and are finally rejected and on appeal. Claims 1, 11, and 21 are independent claims.

IV. Status of Amendments

No amendments were made after the final Office Action. The Applicant filed a Reply on September 24, 2002 after the final Office Action. The Reply did not amend any claims. The Examiner mailed an Advisory Action on October 16, 2002 maintaining the final rejection.

V. Summary of Invention

The Applicant's invention generally relates to computer auctioning methods and systems and, more particularly, to an auctioning method and system for a computer network having a scan site and an auction site in which the scan site monitors the auction site and compares a list of desired products to the products being sold on the auction site to determine which desired products are being sold. (See page 1, lines 3-8 of the Applicant's specification.)

With reference FIGS. 1-2; page 2, line 7 through page 3, line 27; and page 4, line 14 through page 6, line 28 of the Applicants's specification, the Applicant's invention is generally directed to a method and an associated system for auctioning a product on a computer network (16) such as the Internet. The computer network (16) includes a scan host computer (20) and an auction host computer (24). The scan host computer (20) and the auction host computer (24) have associated scan and auction sites (18, 22). Each scan site (18) is associated with a respective buyer (12). The buyer (12) enters descriptions in the associated scan site (24) of items or products that the buyer is interested in buying. As such, the scan site (18) has a desired product identifier which is indicative of a product desired by the buyer. (See page 2, lines 21-26; page 4, lines 14-23; and page 5, lines 6-19 of the Applicant's specification.)

Each auction site (22) is associated with a respective seller (14). The seller (14) enters descriptions in the associated auction site (22) of items or products that the seller is interested in selling. As such, the auction site (22) has a sale product identifier indicative of a product for sale by the seller (14). (See page 2, lines 21-26; page 4, line 24 through page 5, line 5; and page 5, lines 20-25 of the Applicant's specification.)

The method includes the scan site (18) monitoring the auction site (22) using electronic data interchange (EDI) messaging or the like in order to compare the desired product identifier on the scan site (18) with the sale product identifier on the auction site (22). The scan site (18) determines from the comparison between the desired product identifier and the sale product identifier whether the product desired by the buyer (12) is for sale on the auction site (22) by the seller (14). (See page 2, line 26 through page 3, line 4; and page 5, line 26 through page 6, line 8 of the Applicant's specification.)

As such, scan site (18) automatically monitors auction site (22) and other auction sites. This relieves buyer (12) from having to manually scan the auction sites (22) to determine if desired products are being auctioned for sale by sellers and which auction

sites are selling the desired products. (See page 2, lines 7-16; and page 6, lines 8-12 of the Applicant's specification.)

The method further includes the auction site (22) monitoring the scan site (18) using EDI messaging or the like to identify the desired product identifier placed on the scan site (18) in order to enable the seller (14) to determine the product desired by the buyer (12). As such, auction site (22) automatically monitors scan site (18) and other scan sites. This relieves seller (14) from having to manually scan the scan sites (18) in order to determine which products are desired by buyers. (See page 2, lines 17-20; page 3, lines 7-8; and page 6, lines 23-28 of the Applicant's specification.)

VI. Issue

The Examiner has finally rejected claims 1-9, 11-19, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over www.biddersedge.com ("Bidder's Edge") in view of U.S. Patent No. 5,978,758 issued to McGovern et al. ("McGovern"). The issue on appeal is whether Bidder's Edge in view of McGovern makes a *prima facie* showing of obviousness of claims 1-9, 11-19, and 21-23.

VII. Grouping of Claims

Claims 1-9, 11-19, and 21-23 stand or fall together.

VIII. Argument

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To establish *prima facie* obviousness of a claimed invention, <u>all</u> the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

1.   *Background of the Claimed Invention*

The Background Art section of the Applicant's specification describes typical Internet based auctions. In such auctions sellers place their merchandise for sale and buyers bid for the items to be auctioned. On the closing date, the auctioneer determines the winning buyer with the highest bid and informs the winning buyer of same. The auctioneer may then act as a clearinghouse thereafter to transfer the merchandise to the winning buyer in exchange for the bid. Buyers generally have an idea or a list of items that they would be interested in purchasing through an auction.

As described in the Background Art section of the Applicant's specification, there are generally two disadvantages associated with typical Internet based auctions. The disadvantages are as follows:

1. Buyers do not know when and which Internet auctions sites have the desired merchandise available for auction. As such, the buyers have to periodically watch the different Internet auction sites, almost on a daily basis, for the desired merchandise to determine when the desired merchandise becomes available for auctioning; and

2. Sellers do not, at least initially, know exactly the kind of demand for merchandise that they would like to sell. As such, typical Internet based auctions are supply driven and have no regard to the demand side of the equation. Sellers would place more merchandise for sale if they knew that demand for the merchandise indicated that the sellers are likely to obtain a higher value by selling the merchandise through an auction than the value of holding onto the merchandise.

Accordingly, what is needed is a method and system for Internet based auctions in which the basic principles of supply and demand are followed more accurately than existing Internet based auctions.

2. *The Claimed Invention*

The claimed invention satisfies the above-described need. As recited in independent claims 1, 11, and 21, the claimed invention is directed to a method and an associated system for auctioning a product on a computer network having an auction site and a scan site in which the auction site has a sale product identifier indicative of a product for sale by a seller.

The method includes placing a desired product identifier on the scan site. The desired product identifier is indicative of a product desired by the buyer. The auction site is then monitored by the scan site in order to compare the desired product identifier

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on the scan site with the sale product identifier on the auction site. Based on the comparison between the desired product identifier and the sale product identifier it is determined whether the product desired by the buyer is for sale on the auction site by the seller. The auction site monitors the scan site to identify the desired product identifier placed on the scan site in order to enable the seller to determine the product desired by the buyer.

3. *Bidder's Edge and McGovern*

The Examiner posited that Bidder's Edge teaches the claimed invention with the exception of teaching a method of scanning the database of desired products from the auction site in order to determine a product desired by the buyer.

The Examiner cited McGovern as teaching a job search system where companies (sellers) input available jobs (products). Job seekers (buyers) submit input (resumes) on desired jobs and if a match is found they are notified. The Examiner cited col. 18, lines 39-51 of McGovern for teaching that companies can search from the website the database of jobs desired by job seekers to determine which jobs are desired by the job seekers. The Applicant notes that the companies search from the website for resumes of job seekers in the jobs database by using a keyword search (see col. 18, lines 39-51 of McGovern).

The Examiner posited that it would have been obvious to search the desired product database of Bidder's Edge in the manner taught by McGovern in order to find potential markets for products sellers wish to sell.

4. *The Claimed Invention Compared with Bidder's Edge and McGovern*

The claimed invention generally differs from any combination of Bidder's Edge and McGovern in that the claimed invention takes into consideration the demand side of an auction by enabling the seller to determine the demand for products desired by a buyer without the seller having to directly monitor the scan site. This feature is accomplished by the auction site (as opposed to the seller) monitoring the scan site to identify the desired product identifier placed on the scan site in order to enable the seller to determine the product desired by the buyer.

As a result, in addition to solving the problem of buyers having to monitor various auction sites to determine when a desired product becomes available for auctioning by a seller, the claimed invention also solves the converse problem of sellers having to monitor various scan sites to determine when a product is desired to be purchased through an auctioning by a buyer. As such, the seller need only communicate with the auction site instead of directly with the scan site. This feature which solves the problem of a seller having to directly monitor the scan site to determine the desired products is neither taught nor suggested by the combination of Bidder's Edge and McGovern.

For instance, as noted by the Examiner, McGovern teaches that companies can search from a website (i.a., an auction site) a database (i.e., a scan site) having jobs desired by job seekers to determine which jobs are desired by the job seekers. McGovern teaches that individuals of the companies such as hiring contacts perform this search by using a keyword search to find resumes of interest. (See col. 18, lines 39-51 of McGovern.) As a result, the hiring contact directly monitors the database of jobs from the website by using the keyword search to determine the desired jobs. As such, McGovern suffers the same disadvantages associated with the problem of sellers in an Internet based auction having to directly monitor something such as a scan site in order to determine which products are desired by buyers.

Assuming that it would have been obvious to combine the search system of McGovern to search the auction system of Bidder's Edge, such combination does not result in the claimed invention as McGovern teaches a configuration in which the seller would directly monitor the product database of Bidder's Edge by performing a manual keyword search. Such a combination differs from the claimed invention which includes monitoring the scan site with the auction site to identify the desired product identifier placed on the scan site in order to enable the seller to determine the product desired by the buyer. As such, the Applicant believes that the claimed invention is patentable over any combination of Bidder's Edge and McGovern.

5. *Reply to the Advisory Action*

The Examiner noted in the Advisory Action that based on the broadest definition of "monitoring" the claims do not overcome the prior art (i.e., the combination of Bidder's Edge and McGovern).

The Applicant notes that each of independent claims 1, 11, and 21 recite that the limitation of monitoring the scan site with the auction site. As such, the claims do overcome the prior art because the <u>auction site</u> monitors the scan site in order for a seller to determine products desired by the buyer as opposed to the <u>seller</u> monitoring the scan site or an individual performing a keyword search in order to determine such information (as taught by McGovern).
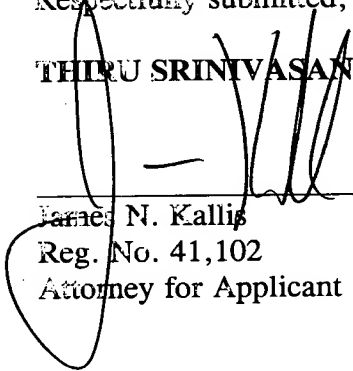
Therefore, independent claims 1, 11, and 21 are patentable over any combination of Bidder's Edge and McGovern under 35 U.S.C. § 103(a). Claims 2-9, 12-19, and 22-23 depend from one of the independent claims. As a result, Bidder's Edge in view of McGovern does not make a *prima facie* showing of obviousness of claims 1-9, 11-19, and 21-23.

IX. Summary

It is respectfully submitted that claims 1-9, 11-19, and 20-23 are allowable for the reasons discussed above.

Respectfully submitted,

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APPENDIX

1.   A method of auctioning a product on a computer network having an auction site and a scan site, wherein the auction site has a sale product identifier indicative of a product for sale by a seller, the method comprising:

placing a desired product identifier on the scan site of the computer network, the desired product identifier indicative of a product desired by the buyer;

monitoring the auction site with the scan site;

comparing the desired product identifier on the scan site with the sale product identifier on the auction site;

determining from the comparison between the desired product identifier and the sale product identifier whether the product desired by the buyer is for sale on the auction site by the seller; and

monitoring the scan site with the auction site to identify the desired product identifier placed on the scan site in order to enable the seller to determine the product desired by the buyer.

2.   The method of claim 1 further comprising:

notifying the buyer when the product desired by the buyer is for sale on the auction site by the seller.

3.   The method of claim 2 wherein:

notifying the buyer includes notifying the buyer using electronic mail.

4.   The method of claim 1 wherein:

each of the product identifiers includes a category product identifier, wherein comparing the desired product identifier with the sale product identifier includes comparing the category product identifier on the scan site with the category product identifier on the auction site.

5.   The method of claim 1 wherein:

each of the product identifiers includes a description product identifier, wherein comparing the desired product identifier with the sale product identifier includes comparing the description product identifier on the scan site with the description product identifier on the auction site.

6.   The method of claim 1 wherein:

the auction site includes a plurality of auction sites.

7.   The method of claim 1 wherein:

monitoring the auction site with the scan site includes monitoring the auction site with the scan site using electronic data interchange messaging.

8.   The method of claim 2 further comprising:

placing a bid from the buyer to the auction site for the product desired by

the buyer.

9.   The method of claim 2 further comprising:

removing the desired product identifier from the scan site in response to the

buyer being notified that the product desired by the buyer is for sale on the auction site

by the seller.

11.   A computer network auctioning system comprising:

an auction host computer having an auction site, wherein the auction site

has a sale product identifier indicative of a product for sale by a seller; and

a scan host computer having a scan site, wherein the scan host computer

is operable for placing a desired product identifier on the scan site of the computer

network, the desired product identifier indicative of a product desired by a buyer, the scan

host computer operable to monitor the auction site, compare the desired product identifier

on the scan site with the sale product identifier on the auction site, and determine from the

comparison between the desired product identifier and the sale product identifier whether

the product desired by the buyer is for sale on the auction site by the seller;

wherein the auction host computer monitors the scan site to identify the

desired product identifier placed on the scan site in order to enable the seller to determine

the product desired by the buyer.

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12.   The system of claim 11 wherein:

the scan host computer is further operable to notify the buyer when the product desired by the buyer is for sale on the auction site by the seller.

13.   The system of claim 12 wherein:

the scan host computer notifies the buyer using electronic mail.

14.   The system of claim 12 wherein:

the scan host computer is operable for placing a bid from the buyer to the auction site for the product desired by the buyer.

15.   The system of claim 12 wherein:

the scan host computer is operable for removing the desired product identifier from the scan site in response to the buyer being notified that the product desired by the buyer is for sale on the auction site by the seller.

16.   The system of claim 11 wherein:

each of the product identifiers includes a category product identifier, wherein the scan host computer compares the category product identifier on the scan site with the category product identifier on the auction site.

17.   The system of claim 11 wherein:

each of the product identifiers includes a description product identifier,

wherein the scan host computer compares the description product identifier on the scan

site with the description product identifier on the auction site.

18.   The system of claim 11 wherein:

the auction site includes a plurality of auction sites.

19.   The system of claim 11 wherein:

the scan host computer monitors the auction site with the scan site using

electronic data interchange messaging.

21.   A method of auctioning a product on a computer network having

a plurality of auction sites and a scan site, wherein each of the auction sites have sale

product identifiers indicative of products for sale by sellers, the method comprising:

placing desired product identifiers on the scan site of the computer network,

the desired product identifiers indicative of products desired by buyers;

monitoring the auction sites with the scan site;

comparing the desired product identifiers on the scan sites with the sale

product identifiers on the auction sites;

determining from the comparison between the desired product identifiers and the sale product identifiers whether products desired by the buyers are for sale on the auction sites by the sellers; and

monitoring the scan site with the auction sites to identify the desired product identifiers placed on the scan site in order to enable the sellers to determine the products desired by the buyers.

22.   The method of claim 21 further comprising:

notifying buyers which auction sites the sellers are selling products desired by the buyers when the products desired by the buyers are for sale on the auction sites by the sellers.

23.   The method of claim 22 further comprising:

notifying the buyers of the current bid of the products desired by the buyers for sale on the auction sites by the sellers.